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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/840,670	04/23/2001	Edward O. Clapper	INTL-0539-US (P10899)	4133
7590	08/31/2004		EXAMINER	
Timothy N. Trop TROP, PRUNER & HU, P.C. 8554 KATY FWY, STE 100 HOUSTON, TX 77024-1805			PESIN, BORIS M	
			ART UNIT	PAPER NUMBER
			2174	

DATE MAILED: 08/31/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/840,670	CLAPPER, EDWARD O.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Boris Pesin	2174	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 10 May 2004.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-10, 12-22, 24-28 and 30 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-10, 12-22, 24-28, and 30 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

1. This communication is responsive to Request for Continued Examination, filed 5/10/2004.

2. Claims 1-10, 12-22, 24-28, and 30 are pending in this application. Claims 1, 13, and 24 are independent claims. In the RCE, Claims 1, 2, 13, 14, 24 and 25 were amended. This action is made Non-Final.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 30 recites the limitation "said user selectable message" in first and second lines of the claim. There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, 12, 13, 14, 24 and 25 are rejected under 35 U.S.C. 102(e) as being anticipated by anticipated by King et al. (US 6307549).

In regards to claim 1, King teaches a method comprising: audibly providing a plurality of user selectable sentence portion options (i.e. “*Additional auditory feedback may be provided to the user by including a voice synthesizer as an application program 112, 114 in the disambiguating system. As a user enters keystrokes, the voice synthesizer announces the first entry in the selection list. To allow typing to proceed unimpeded, the first entry is announced after a slight delay. The user may also cause the first entry to be spoken immediately by pressing the select key. The auditory feedback provided by a voice synthesizer allows visually-impaired users to use the system without having to view the selection list.*” Column 18, Line 10); enabling the user to compose a sentence by selecting from among the available sentence portion options by making a key selection (i.e. Figure 11, Element 1206).

In regards to claim 2, King teaches a method wherein providing options includes displaying a graphical user interface listing a plurality of sentence portion options (i.e. Figure 11, Element 1206).

In regard to claim 12, King teaches a method that includes enabling the user to compile a message by selecting from available message options by making key selections on a telephone (Figure 1B).

Claims 13 and 14 are in the same context as claims 1 and 2; therefore they are rejected under similar rationale.

Claims 24 and 25 are in the same context as claims 1 and 2; therefore they are rejected under similar rationale.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 3 –10, 15 – 22, 26, 27, 28, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over King et al. (US 6307549) in view of Stoddard (<http://rinkworks.com/crazylibs/>).

In regards to claim 3, King teaches all the limitations of claim 2. He does not teach a method that provides a plurality of pre-selected display segments and providing a plurality of user selectable options for each segment. Stoddard teaches a method that provides a plurality of pre-selected display segments (See

Figure 2, Elements 1 and 2) and providing a plurality of user selectable options for each segment (See Figure 3, Element 1). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify King with the teachings of Stoddard and include a method to have a plurality of preselected display segments and provide a plurality of options for each segment with the motivation to provide for easy creation of sentences.

In regards to claim 4, King and Stoddard teach all the limitations of claim 3. King does not teach a method that includes displaying a list of user-selectable options for a plurality of display segments. Stoddard further teaches a method that includes displaying a list of user-selectable options for a plurality of display segments (See Figure 3, Element 1).

In regards to claim 5, King and Stoddard teach all the limitations of claim 4. King does not teach a method that includes enabling the options to be displayed as a list of options. Stoddard teaches a method that includes enabling the options to be displayed as a list of options (See Figure 3, Element 1).

In regards to claim 6, King and Stoddard teach all the limitations of claim 5. King does not further teach a method enabling the user to mouse select an option from each of the plurality lists to complete a message. Stoddard does not specifically teach a method of enabling the user to mouse select an option from each of the plurality lists to complete a message, however this feature is inherent in Stoddard.

In regards to claim 7, King and Stoddard teach all the limitations of claim 6. King does not teach a method that includes displaying a graphical user

interface in association with each of a plurality of display segments. Stoddard teaches displaying a graphical user interface in association with each of a plurality of display segments (See Figure 2, Elements 1 and 2).

In regards to claim 8, King and Stoddard teach all the limitations of claim 7. King does not teach a method that includes linking a list of options to a display segment so that when an option is selected it appears on a display associated with a particular display segment. Stoddard teaches a method that includes linking a list of options to a display segment so that when an option is selected it appears on a display associated with a particular display segment (See Figure 2, Elements 1 and 2).

In regards to claim 9, King teaches all the limitations of claim 1. King does not teach a method that includes generating an interface displaying said options and conveying said interface to a local system over a network. Stoddard teaches a method to generate an interface displaying said options and conveying said interface to a local system over a network (See Figures 2 and 3, since Stoddard's invention is on the internet it is inherent that the data is transferred through a network). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify King with the teachings of Stoddard and include a method to generate and convey an interface over a network with the motivation to provide for easy access to the interface for the user.

In regards to claim 10, King teaches all the limitations of claim 1. King does not teach a method that includes generating a graphical user interface to locally display said options, developing said message locally, and transmitting

said message remotely over a network. Stoddard teaches a method that includes generating a graphical user interface to locally display said options, developing said message locally, and transmitting said message remotely over a network (The message options are locally displayed (See Figures 2 and 3, then the user is completed they hit the “done” button (Figure 4, Element 1) and the data is transferred over the network to compile the message (Figure 5).

Claims 15-22 are in the same context as claims 3-10; therefore they are rejected under similar rationale.

Claim 26 is in the same context as claims 3; therefore it is rejected under similar rationale.

In regards to claim 27, King teaches all the limitations of claim 24. He does not teach that his invention consists of a server. Stoddard does not specifically teach that his invention contains a server, however it is inherent due to the fact that his invention relies on the Internet. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify King with the teachings of Stoddard and include a server with the motivation to provide more accessibility to the sentence creating apparatus.

In regards to claim 28, King teaches all the limitations of claim 24. He does not teach that his invention consists of a client. Stoddard does not specifically teach that his invention contains a client, however it is inherent due to the fact that his invention relies on the Internet.

In regards to claim 30, King teaches all the limitations of claim 24. He does not teach that his invention is coupled to a telephone network to provide

said user selectable massage options over a telephone. Stoddard does not specifically teach that his invention is coupled to a telephone network to provide said user selectable massage options over a telephone, however it is inherent due to the fact that his invention relies on the Internet and a telephone network can be used to access the Internet.

***Response to Arguments***

Applicant's arguments with respect to claims 1-10, 12-22, 24-28, and 30 have been considered but are moot in view of the new ground(s) of rejection.

***Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Boris Pesin whose telephone number is (703) 305-8774. The examiner can normally be reached on Monday-Friday except every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kristine Kincaid can be reached on (703) 308-0640. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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